

PATENT

231/198

#1
Newm.
11-05-99

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of: Margolis *et al.*

Serial No.: 09/012,369

File Date: January 23, 1998

For: METHODS FOR TREATMENT OR
DIAGNOSIS ASSOCIATED WITH
AN APB DOMAIN

Art Unit: 1642

Examiner: Eyler, Y.

RESPONSE TO ELECTION REQUIREMENTAssistant Commissioner for Patents
Washington, D.C. 20231

Sir:

In response to the Election Requirement mailed October 8, 1999, please consider the following remarks.

Applicants hereby elect to prosecute, with traverse, the species designated as species (a), in the Election Requirement mailed October 8, 1999, namely cancers/neoplasms.

Pending claims 1-10 and 19-25 are drawn to the elected species.

Applicants respectfully traverse the election of species requirement between the species of disease cancers/neoplasms, CNS and neurological disorders, traumas/injuries, musculo-skeletal disorders, and cardiovascular disorders. Election of species is not proper when there is not a serious burden on the Examiner if election is not required (*see* MPEP 803). Specifically, in

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CERTIFICATE OF MAILING
(37 C.F.R. §1.10)

I hereby certify that this paper (along with any referred to as being attached or enclosed) is being deposited with the United States Postal Service on the date shown below with sufficient postage as First Class Mail in an envelope addressed to the Assistant Commissioner for Patents, Washington, D.C. 20231.

OCTOBER 29, 1999
Date of DepositLINDA JONKERS-YOC OM
Name of Person Mailing Paper

Signature of Person Mailing Paper

the present case, Applicants do not believe that there would be a serious burden on the Examiner if election is not required between the five diseases or disorders. Applicants maintain that the Examiner incorrectly observes that the diseases have "different characteristics, and different chemical/biochemical/biological interactions." An aspect of the invention relates to the notion that all of the above-mentioned diseases or disorders are "characterized by abnormal cellular signal transduction involving a newly identified region, herein termed the 'APB domain.'" Specification at page 4, lines 19-21. A search by the Examiner for these diseases or disorders would not be unduly burdensome to the Examiner. Accordingly, reconsideration and withdrawal of the election of species requirement are respectfully requested.


CONCLUSION

Applicants believe that the claims are now in condition for allowance and a notice to that effect is respectfully requested. No fee is believed due in connection with this response. If this is incorrect, please charge Lyon & Lyon Deposit Account No. 12-2475 for the appropriate amount. Should the Examiner believe that a telephone interview would aid in the prosecution of this application, Applicants encourage the Examiner to call the undersigned collect at (858) 552-8400.

Respectfully submitted,

LYON & LYON, LLP

Dated: 10/29/99



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